AUG4 1980
MICHAEL RODAK, JR., CLE

No. 80-13

In the Supreme Court of the United States

OCTOBER TERM, 1979

SIDNEY A. DIAMOND,
COMMISSIONER OF PATENTS AND TRADEMARKS,
PETITIONER,

v.

TOMAS HIRSCHFELD, MARVIN MARGOSHES
AND BLOCK ENGINEERING, INC.
RESPONDENTS.

RESPONDENTS' OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR RESPONDENTS

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Blanchard Press, Inc., Boston, Mass.—Law Printers

QUESTIONS PRESENTED

The only question considered by the Court of Appeals regarding 35 U.S.C. 101 was, as originally presented by petitioner, " . . . whether the findings of the District Court, that Appellees claims are patentable as a process (sic) under 35 U.S.C. 101, is further clearly erroneous, thus requiring reversal.". In view of the per curiam decision of the Court of Appeals, this question, unchanged, should remain the question before this Court. The question now presented by petitioner to this Court is directed to an issue not addressed by the Court of Appeals below.

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BRIEF FOR RESPONDENTS

Respondents oppose the petition for a writ of certiorari filed by petitioner to review the judgment of the United States Court of Appeals for the District of Columbia in this case.

STATUTES INVOLVED

35 U.S.C. 101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 103 states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention ****

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. 145 states:

An appellant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

28 U.S.C. 2101 (f) states.

In any case in which the final judgment or decree of any court is subject to review by the Supreme Court on writ of certiorari, the execution and enforcement of such judgment or decree may be stayed for a reasonable time to enable the party aggrieved to obtain a writ of certiorari from the Supreme Court. The stay may be granted by a judge of the court tendering the judgment or decree or by a justice of the Supreme Court, and may be conditioned on the giving of security, approved by such judge or justice, that if the aggrieved party fails to make application for such writ within the period allotted therefor, or fails to obtain an order granting his application, or fails to make his plea good in the Supreme Court, he shall answer for all damages and costs which the other party may sustain by reason of the stay.

STATEMENT OF THE CASE

Petitioner's statement of the case requires restatement to correct numerous inaccuracies.

Respondents Hirschfeld and Margoshes filed the pertinent patent application in 1971, directed to a Digitally Controlled Electro-optical Imaging System most accurately described in claim 15 of the application (App. B, 4a). To describe part of the invention, the application included at Fig. 3, a flow chart (App. B, 6a) which could be implemented according to the specification (R. 173)* ". . with a discrete component or 'hard-wired' system, or alternatively with a general purpose computer with an appropriate program or 'software'.".

The Examiner and subsequently the Board of Appeals of the United States Patent and Trademark Office, taking the position that implementation of the functions set forth in the flow chart would require more than routine experimentation (App. C, 21a), rejected the claims on the sole ground that the specification failed to enable one skilled in the art to make and use the claimed system as required by 35 U.S.C. 112, first paragraph. (App. C, 24a).

Respondents timely filed a complaint, under 35 U.S.C. 145, in the United States District Court for the District of Columbia to compel the Commissioner of Patents and Trademarks to issue a patent on the system claimed in the instant patent application. Less than a week before trial, the Commissioner moved to amend his answer to raise for the first time the defense that respondents' claims were unpatentable under 35 U.S.C. 101 as ". . . being directed to a mathematical algorithm at the point of novelty." (App. B, 12a).

At trial in the District Court, testimony of witnesses skilled in the art established that the specification of the patent application at issue contained sufficient information to enable one to make and use the claimed system. The testimony refer-

* "R." refers to the record on appeal in the Court of Appeals

red to a computer program prepared by one of the witnesses from the teachings of the patent application, solely for the purpose of proving enablement at trial. Petitioner concedes proof of such enablement, as shown by the footnote (n.7) in his petition.

As to the issue under 35 U.S.C. 101 raised on the eve of trial, the trial court concluded that the claims ". . . neither recite nor contain an 'algorithm' within the meaning of *Parker* v. *Flook* . . .". 435 U.S. 584 (1978). (App. B, 15a).

Subsequently, the Court of Appeals, per curiam, found no error in any of the findings of fact or conclusions of law of the trial court, and summarily affirmed the decision of the latter. (App. A, 1a)

ARGUMENT

I. The Issues Raised by Petitioner Are Spurious Inasmuch as Respondents Do Not Seek to Patent Any Computer Program.

Petitioner is incorrect in asserting that the Commissioner of Patents and Trademarks contended that everything in the claims was old except for the computer program. As noted above, the specification particularly indicates (R. 173) that use of a computer was but one way in which certain functions of the invention could be implemented, another way being through ordinary electrical circuitry. Hence, no computer program needed to be or was in fact claimed. Examination of the claims (App. B, 4a, 5a) in issue fails to reveal any computer program whatever. The existence of a computer program, whether as part of a patent specification or as evidence of enablement submitted at trial, cannot and should not be construed as an attempt by respondents to patent that computer program where the latter is absent from the claims. The scope of a patent is measured only by its claims. *Graver Tank &*

Mfg. Co., Inc. v. *The Linde Air Products Company*, 336 U.S. 271, 277 (1949). Thus, Petitioner is incorrect in asserting that this case presents an important issue of the patentability of computer programs.

In several respects, the purported analysis made by petitioner regarding the instant patent application, supposedly in the light of *Parker* v. *Flook*, supra, is fallacious in contending that ". . . the only arguably novel aspect of the respondents' claims are the functions described in the limitations in their claims that respondents' expert acknowledged were performed by a computer program . . .". This contention distorts the requirements of 35 U.S.C. 101 by engrafting the novelty requirements of other sections of 35 U.S.C. thereon, without authority in either statute, rule or case law; and if novelty is a consideration in 35 U.S.C 101, then it ignores the requirement of 35 U.S.C. 103 that novelty is related to the subject matter, *as a whole*, sought to be patented. Also, this contention of petitioner ignores the sanction given by 35 U.S.C. 112 (last paragraph): respondents may recite structural elements of their claims in terms of means plus function. Petitioner would separate the function from the structure in derogation of the clear meaning of the statute.

Lastly, but most importantly, the alleged "acknowledgement" by respondents' witness is misstated. The actual assertion by the witness, referring to the computer program prepared only for the purpose of trial was:

> "The program, *together with interface hardware built according to the specification* and so forth . . . would provide implementation to support the claim." (R. 154) (Emphasis supplied).

This testimony is completely consistent with respondents' efforts to prove *enablement* under 35 U.S.C. 112, and cannot and should not be twisted by interpreta-

tion into an admission or an acknowledgement that respondents are attempting to claim a computer program in supposed conflict with 35 U.S.C. 101.

Petitioner seeks to have this Court review the evidence and draw therefrom an inference that respondents seek to patent a computer program, contrary to the findings of the Courts below. Justice Holmes has pointed out that this Court will not "grant a certiorari to review evidence and discuss specific facts." *United States* v. *Johnston*, 268 U.S. 220, 227 (1924). *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175 (1938).

II. The Cases With Which Petitioner Seeks to Group the Instant Case, Are Clearly Distinguishable.

Petitioner notes that in several pending cases, *Diamond* v. *Bradley*, *Diamond* v. *Diehr* and *Diamond* v. *Sherwood*, (all hereinafter referred to as the Computer Cases) petitions for certiorari have either been granted or are awaiting decision, contending that these Computer Cases present the same basic question as is presented in the instant case. Petitioner incorrectly asserts in his petition that "In each case, the Court below, relying on Court of Customs and Patent Appeals precedent, considered it dispositive that the algorithm was not 'mathematical'." In the instant case, the Court below did not rely on precedent of the Court of Customs and Patent Appeals. To the contrary, the Court below adopted the decision of the District Court which, in Conclusion of Law No. 9 (App. B, 12a) explicitly relied only on this Court's decisions in *Parker* v. *Flook*, supra, and *Gottschalk* v. *Benson*, 409 U.S. 63 (1972).

Respondents have not been provided with the briefs in all of the Computer Cases, supra. Respondents however should not be obliged to refer to such briefs, for they are not authority but merely argument in unrelated matters. Petitioner seeks to group all of the Computer Cases, supra, together with the

instant case on the basis of the false proposition that they contain a common issue. While it is difficult to refute such position without having the records of all of these cases available, major differences are nevertheless apparent and material.

All three of the Computer Cases, supra, involve petitions from decisions of the Court of Customs and Patent Appeals. The instant petition is directed to a decision of the Court of Appeals for the District of Columbia. Petitioner's contention that the decision in the instant case is "Another example of the same refusal" of the Court of Customs and Patent Appeals to follow *Parker* v. *Flook*, supra, is plainly wrong. The identity of the trial judge in the instant case, is not in any proper manner material to the present issues, notwithstanding petitioner's argument.

The Computer Cases, supra, were never adjudicated on the trial level, but were brought before the Court of Customs and Patent Appeals directly from the United States Patent and Trademark Office. On the other hand, the instant case was fully tried before the District Court and affirmed by the Court of Appeals. The difference is significant for it calls into operation the so-called "two-court rule". In *Graver Tank* v. *Linde Air Products*, supra, at 273 this Court stated:

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact of two courts below in the absence of very obvious and exceptional showing of error. *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275; *District of Columbia* v. *Pace*, 320 U.S. 698; *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U.S. 364; *Baker* v. *Schofield*, 243 U.S. 114, 118."

No such showing has been made by petitioner in the instant case.

CONCLUSION

In his conclusion, petitioner asks that the petition be held pending this Court's decision in the Computer Cases supra, cases not related to the instant case either in terms of parties or real issues. The petitioner's request appears to be for a stay of judgment of the court below; if so, it is improperly presented in the guise of a petition for certiorari, does not conform to 28 U.S.C. 2101 or Rule 35 of this Court, would deny respondents any right to challenge petitioner's request for a stay, and should therefore be denied. The patent application involved in this case has been pending in the United States Patent and Trademark Office from 1971 to 1975 and in the courts since that date. Notwithstanding the variety of positions taken by petitioner since 1971 in efforts to block respondents right to a patent, the courts below have unanimously held for respondents. Further delay would constitute a denial of justice. Respondents pray that this Court dispose of the instant case by refusing both issuance of the requested writ and grant of the request that the petition be "held".

Respectfully submitted,

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July, 1980